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Etsuto Nakatsu

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EXAMINER

DAZENSKI, MARC A

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/596,283	<b>Applicant(s)</b> NAKATSU, ETSUTO	
	<b>Examiner</b> MARC DAZENSKI	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 26 September 2009 have been fully considered but they are not persuasive.

Regarding the numbering of the claim rejections under 103(a), Applicant is correct in that the section header is misnumbered. Applicant is further correct in that the intended claims were 1, 3-5, 7-8, 11-12, and 14-16. The examiner regrets the error and has corrected the numbering in the rejection appearing below.

On pages 8-9 of the remarks, Applicant argues that in Honjo, "...the user must initiate a request that the 9-Mbps CBR/TS data to be converted to 3-Mbps VBR/PS data. In other words, a user must provide an instruction to dub the 9-Mbps CBR/TS data stored on the HDD (8) to the optical disk (9)," and further that "...neither Honjo nor Nomura et al operates in a 'default' manner in which the second data stream is created and recorded on a hard disk absent specific instruction from the user." The examiner respectfully disagrees.

Applicant refers to paragraphs [0072], [0079], and [0084] in formulating their arguments. However, a careful reading of the cited paragraphs does not disclose a user initiating any recording or re-encoding process. Although [0071] does disclose a "case where when the data are to be dubbed onto the optical disk (9)," there is no specific mention of a user input determining the request; therefore, these cited sections do not preclude the case where the system records or re-encodes the data from 9-Mbps

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CBR/TS into 3-Mbps VBR/PS absent any special user instruction. Further, [0071] discloses "...the data are converted into data of a 3-Mbps variable bit rate and then recorded..." As written, the phrase allows for the instance where the data is converted and then recorded at some undisclosed later point; the examiner is interpreting the reference as such, and therefore maintains that the combination of Honjo and Nomura therefore teaches all limitations of the claim (wherein Honjo discloses recording first and second data streams into different media, and Nomura teaches an instruction receiving section for determining, among other things, what is to be deleted and when).

On pages 9-10 of the remarks, Applicant introduces new claim 17 and explains why it is distinguishable over the prior art of record. The examiner respectfully disagrees, and a full rejection of the claim appears below.

A full rejection of all remaining pending claims appears below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3-5, 7-8, 11-12, and 14-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Honjo (US PgPub 2002/0061181), hereinafter referred to as Honjo, in view of Nomura et al (US PgPub 2001/0024562), hereinafter referred to as Nomura.

Regarding **claim 1**, Honjo discloses a method and apparatus for recording/reproduction. Further Honjo discloses a recording/reproduction apparatus for dubbing AV data from an HDD to an optical disk, wherein the data on the HDD is recorded in 9-Mbps CBR/transport stream formats and is then converted to 3-Mbps VBR/program stream formats so as to be dubbed onto an optical disk, which reads on the claimed, "a data processor having ability to write a data stream on each of storage media of first and second types, wherein first and second data streams in mutually different formats are allowed to be written on the first type of storage medium, while the second data stream is allowed to be written on the second type of storage medium," as disclosed at paragraphs [0071]-[0073] and exhibited in figure 1; the apparatus comprising:

terminal (22) which receives an inputted video signal in the form of a digital broadcast signal, which reads on the claimed, "a receiving section for receiving the first data stream," as disclosed at paragraphs [0078]-[0079] and exhibited in figure 1;

video coding means (2) and stream converting means (5) which convert the 9-Mbps CBR/TS data on the HDD to 3-Mbps VBR/PS data, which reads on the claimed, "a converting section for converting the first data stream into the second data stream," as disclosed at paragraphs [0072]-[0073], [0081] and [0084];

recording means (7) which records the above mentioned streams onto the HDD, which reads on the claimed, "a processing section for writing the first and second data streams on the first type of storage medium," as disclosed at paragraphs [0072], [0079], and [0084], as well as exhibited in figure 1; and,

the 9-Mbps CBR/TS data are converted to 3-Mbps VBR/PS data and recorded into the hard drive (8), which reads on the claimed, “wherein before the instruction section receives the instruction to dub the content, the converting section converts the first data stream into the second data stream and the processing section writes the second data stream on the first type of storage medium,” as disclosed at paragraphs [0071] – [0073] (see also explanation in “Response to Arguments” above).

However, Honjo fails to disclose an instruction receiving section for receiving, from a user, an instruction to dub the content...wherein if the instruction receiving section receives the instruction to dub the content when both the first and second data streams have been recorded on the first type of storage medium, the processing section reads the second data stream from the first type of storage medium, writes the second data stream from the first type of storage medium, writes the second data stream on the second type of storage medium, and then deletes the second data stream from the first type of storage medium. The examiner maintains it was well known to include the missing limitations, as taught by Nomura.

In a similar field of endeavor, Nomura discloses an information processing apparatus and method as well as program storage medium. Further, Nomura discloses AV contents management search program (82) which controls a display unit (30) to display a copy option setting window (251), which allows a copying of contents recorded on the HDD to be deleted after copied onto the external recording medium which may be an optical disc, which reads on the claimed, “an instruction receiving section for receiving, from a user, an instruction to dub the content...wherein if the instruction

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receiving section receives the instruction to dub the content when both the first and second data streams have been recorded on the first type of storage medium, the processing section reads the second data stream from the first type of storage medium, writes the second data stream from the first type of storage medium, writes the second data stream on the second type of storage medium, and then deletes the second data stream from the first type of storage medium,” as disclosed at paragraphs [0104]-[0111] and exhibited in figures 13-16.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Honjo to include AV contents management search program (82) which controls a display unit (30) to display a copy option setting window (251), which allows a copying of contents recorded on the HDD to be deleted after copied onto the external recording medium which may be an optical disc, as taught by Nomura, for the purpose of making more efficient use of recording capacity on a recording medium.

Regarding **claim 3**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 1). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 1 above.

Regarding **claim 4**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 3). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 3 above.

Regarding **claim 5**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 3). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 3 above.

Regarding **claim 7**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 3). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 3 above (wherein by not selecting the option to copy, this allows the user to decide later whether the contents need to be dubbed).

Regarding **claim 8**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 3). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 3 above (wherein by not selecting the option to copy, this allows the user to decide later whether the contents need to be dubbed, and the content therefore remains on the HDD as exhibited in item (204) of figure 13).

Regarding **claim 11**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 1). Further, Honjo discloses the streams on the HDD (8) are converted from TS to PS, which reads on the claimed, "wherein the first data stream is an MPEG-2 transport stream, and wherein the second data stream is an MPEG-2 program stream," as disclosed at paragraphs [0072] and [0077]-[0084].

Regarding **claims 12 and 14-16**, the examiner maintains that the claims are merely the corresponding method to the apparatus of claims 1 and 3-5, and are therefore rejected in view of the explanation set forth in claims 1, and 3-5 above.

**Claims 2, 13, and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Honjo (US PgPub 2002/0061181), hereinafter referred to as Honjo, in view of



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Nomura et al (US PgPub 2001/0024562), hereinafter referred to as Nomura, further in view of well known prior art (see MPEP 2144.03).

Regarding **claim 2**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 1). However, the combination fails to disclose wherein if the user has instructed that the content not be dubbed, the processing section deletes the second data stream from the first type of storage medium. The examiner maintains that it was old and well-known in the art to delete a data stream from a storage medium, and therefore takes Official Notice (wherein deleting a data stream from a storage medium is an implicit user instruction to not dub the content).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Honjo and Nomura to include wherein if the user has instructed that the content not be dubbed, the processing section deletes the second data stream from the first type of storage medium, for the purpose of making more efficient use of recording capacity on a recording medium.

Regarding **claim 13**, the examiner maintains that the claim is merely the corresponding method to the apparatus of claim 2, and is therefore rejected in view of the explanation set forth in claim 2 above.

Regarding **claim 17**, the examiner notes that many of the limitations correspond to the apparatus of claim 1 (e.g., the preamble, receiving section, converting section, processing section, and first instruction receiving section as well as the first two limitations beginning with "wherein" and drawn toward the first instruction receiving section), and are therefore rejected in view of the explanation set forth in claim 1 above.

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However, there are two limitations that are unique to claim 17 and/or do not correspond to the apparatus of claim 1: “a second instruction receiving section for receiving, from a user, a prescribed instruction...wherein if the second instruction receiving section receives the prescribed instruction before the first instruction receiving section receives the instruction to dub the content, the processing section deletes the second data stream from the first type of storage medium.”

As written, the examiner interprets the “prescribed instruction” to be a deletion instruction, which would make the claimed “second instruction receiving section” act in a manner that simply deletes the second data stream from the first type of storage medium. However, although the combination of Honjo and Nomura does not explicitly disclose the claimed functionality in the same terms as presented by Applicant, the examiner maintains that it was old and notoriously well known in the art to delete a data stream from a storage medium, and therefore takes Official Notice (wherein by deleting the second data stream from the first type of storage medium, a dub instruction cannot be given and therefore this “prescribed instruction” must occur before the “instruction to dub the content”).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Honjo and Nomura to include a second instruction receiving section for receiving, from a user, a prescribed instruction...wherein if the second instruction receiving section receives the prescribed instruction before the first instruction receiving section receives the instruction to dub the content, the processing section deletes the second data stream from the first type of

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storage medium, for the purpose of making more efficient use of recording capacity on a recording medium.

**Claims 6 and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Honjo (US PgPub 2002/0061181), hereinafter referred to as Honjo, in view of Nomura et al (US PgPub 2001/0024562), hereinafter referred to as Nomura, further in view of Cheng et al (US Patent 7,369,750), hereinafter referred to as Cheng.

Regarding **claim 6**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 1). However, the combination fails to disclose wherein unless the content starts to be played back within a predetermined amount of time after the first data stream has been written, the processing section deletes the second data stream. The examiner maintains that it was well known to include the missing limitations, as taught by Cheng.

In a similar field of endeavor, Cheng discloses managing of recorded events. Further, Cheng discloses a program deletion prioritization mechanism for freeing storage space, one of the factors of which is whether the program has been watched or by the age of the recording based on the recording date, which reads on the claimed, “wherein unless the content starts to be played back within a predetermined amount of time after the first data stream has been written, the processing section deletes the second data stream,” as disclosed at column 9, lines 22-48.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Honjo and Nomura to include a program deletion prioritization mechanism for freeing storage space, one of the

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factors of which is whether the program has been watched or by the age of the recording based on the recording date, as taught by Cheng, for the purpose of making more efficient use of recording capacity on a recording medium.

Regarding **claim 9**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 8). Further, the limitations of the claim are rejected in view of the explanation set forth in claim 6 above.

**Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Honjo (US PgPub 2002/0061181), hereinafter referred to as Honjo, in view of Nomura et al (US PgPub 2001/0024562), hereinafter referred to as Nomura, further in view of Goto et al (US Patent 7,239,796), hereinafter referred to as Goto.

Regarding **claim 10**, the combination of Honjo and Nomura discloses everything claimed as applied above (see claim 1). However, the combination fails to disclose wherein when the remaining capacity of the first type of storage medium becomes equal to or smaller than a predetermined value, the processing section deletes the second data stream representing the content that has been registered on the list. The examiner maintains that it was well known to include the missing limitations, as taught by Goto.

In a similar field of endeavor, Goto discloses an information recording and reproducing apparatus. Further, Goto discloses an automatic program deleting process which repetitively checks the capacity on a HDD and in the case of a shortage of a usable capacity, deletes at least a portion of a program, which reads on the claimed, “wherein when the remaining capacity of the first type of storage medium becomes equal to or smaller than a predetermined value, the processing section deletes the

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second data stream representing the content that has been registered on the list,” as exhibited in figure 16 and its accompanying text (column 13, line 34 through column 14, line 61, with particular emphasis on column 14, lines 11-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Honjo and Nomura to include an automatic program deleting process which repetitively checks the capacity on a HDD and in the case of a shortage of a usable capacity, deletes at least a portion of a program, as taught by Goto, for the purpose of making more efficient use of recording capacity on a recording medium.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC DAZENSKI whose telephone number is (571)270-5577. The examiner can normally be reached on M-F, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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